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EXAMINER

THOMPSON JR, FOREST

ART UNIT

PAPER NUMBER

3625

DATE MAILED: 07/01/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/294,461

Applicant(s)

SHANMAN ET AL.

Examiner

Forest O. Thompson Jr.

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 April 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8, 11-13 and 25-40 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8, 11-13, 25-40 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action (See Paper No. 4). The text of those sections of Title 35, U.S. Code not otherwise provided in a prior Office action will be included in this action where appropriate.
2. This action is responsive to the amendment (amendment C) filed 22 April 2002 (see Paper #12) and . Amendment C canceled claims 9 and 14-24, and added new claims 29-40. Claims 1-8, 11-13, and 25-40 are pending.
3. Claims 1-8, 11-13, and 25-40 have been examined.

Drawings

4. The drawings filed on 04/19/99 are acceptable subject to correction of the informalities indicated on the "Notice of Draftsperson's Patent Drawing Review," PTO-948, in the First Action (see Paper #4). Correction is required.

Claim Rejections - 35 USC § 103

5. Claims 1-2, 4-8, 12-15, 17-21, and 23-26 were rejected in Paper #7 under 35 U.S.C. 103(a) as being unpatentable over "Internet Infinity Signs Exclusive Distribution Agreement With ZIP COUPONS," PR Newswire; p106NYM035; 06

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January 1997 (hereafter referred to as "ZIP COUPONS"), and further in view of Storey (U.S. Patent No. 5,774,870), and "Excite Reports First Quarter 1999 Results," PR Newswire, 15 April 1999 (hereafter referred to as Excite). The rejections are maintained. Applicant has amended the claims (see Paper #9).

6. Claims 1-2, 4-8, 12-15, 17-21, and 23-26 were rejected in Paper #10 under 35 U.S.C. 103(a) as being unpatentable over "Internet Infinity Signs Exclusive Distribution Agreement With ZIP COUPONS;" PR Newswire; p106NYM035; 06 January 1997 (hereafter referred to as "ZIP COUPONS"), and further in view of "Excite Reports First Quarter 1999 Results," PR Newswire, 15 April 1999 (hereafter referred to as Excite) and Scroggie et al. (U.S. Patent No. 6,014,634). Applicant has amended the claims in Paper #12. The rejections are maintained, and modified as presented below.

Claims 1-2, 4-8, and 12-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over "Internet Infinity Signs Exclusive Distribution Agreement With ZIP COUPONS;" PR Newswire; p106NYM035; 06 January 1997 (hereafter referred to as "ZIP COUPONS"), and further in view of "Excite Reports First Quarter 1999 Results," PR Newswire, 15 April 1999 (hereafter referred to as Excite) and Scroggie et al. (U.S. Patent No. 6,014,634).

Claim 1: ZIP COUPONS (at pg. 1, para. 2) discloses:

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- a plurality of consumer units operated by a consumer;
- communications means connectable over a communication medium to at least a coupon server; a user input device to permit a consumer to make one or more choices displayed on the display monitor; a coupon server located remotely from the consumer units, comprising:

- a memory for storing first data corresponding to one or more participating retail outlets including data for identifying each of the retail outlets by name and inventory of goods offered for sale, and second data containing coupon data used for generating electronic discount coupons for selected goods;

- a data processing unit having communication means connectable over the communication medium to the consumer units;

- first means responsive to a connection with a respective consumer unit to transmit for display on the display monitor of the respective consumer unit a first rule containing a list of participating retail outlets which may be individually selected by the consumer using the user input device of the respective consumer unit, *through the selection of the types of coupons that the consumer is interested in, and display of available coupons and the associated merchants identified with the coupons;*

- second means responsive to the selection of a retail outlets displayed on the display monitor of the respective consumer unit by the consumer to transmit to the respective consumer unit a second file containing first data corresponding to the selected retail outlet for display on the display

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monitor of the consumer unit, the second file containing the identity of goods offered for sale by the selected retail outlet, and the displayed goods being individually selected by the consumer using the user input device, *as illustrated through the representation and selection of the coupons*; and

-- third means responsive to the selection of one or more items of goods by the consumer to transmit a third file for display on the display monitor of the consumer unit containing second data corresponding to the selected goods, the third file containing electronic coupons corresponding to one or more of the selected goods, *i.e., through the selection of coupons for desired products/services, the consumer is selecting products/services for purchase.*

ZIP COUPONS disclose that advertisers will pay Internet Infinity, Inc for placement of their zip coupons on the Internet and delivery of their mail coupon, and customers will select a coupon interest category for car wash, pizza, etc., which implies that a list of the participating retail outlets are displayed on the display monitor of the consumer unit. However, ZIP COUPONS does not explicitly show the retail outlets are individually selectable by the consumer and in response to the selection of one or more of the displayed retail outlets transmitting a list of goods for which discounts are available. However, this is inferred from the disclosure of ZIP Coupons, as shown above, as the consumer selects the coupons for products that the consumer wants to obtain, and the coupons are provided to the consumer. Official Notice is taken that the consumer may base his choices on any one or more of many parameters, such

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as, cost, size, color, etc. of the choices, as well as, the particular merchant providing the coupon redemption service that sells the products of choice. In this way, the consumer selects the merchant that he prefers. It would have been obvious to one skilled in the art at the time the invention was made to modify ZIP Coupons to specifically disclose the retail outlets are individually selectable by the consumer and in response to the selection of one or more of the displayed retail outlets transmitting a list of goods for which discounts are available, because this is only an obvious variation of the disclosure that results from a slightly different, but obvious, sort of the same database of available goods and coupons. Thus, when coupons are selected for each of the participating stores as disclosed in ZIP COUPONS, products and retail stores are being individually selected by the consumer.

Additionally, EXCITE discloses that consumers are able to access digital redeemable coupons from participating online merchants, all personalized based on an individual's shopping interests (pg. 2 3rd para.), as may be portrayed by a shopping list. It would have been obvious to one skilled in the art at the time the invention was made to modify the invention of ZIP COUPONS to disclose a list of participating retail outlets in such a manner that the retail outlets are individually selectable by the consumer and transmitting a list of goods for which discount coupons are available in order for the individual to view and select products available from the retail outlet, as disclosed by EXCITE, because this would simplify the consumer's selection procedures for goods and retail outlets. When

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coupons are selected for each of the participating stores as disclosed in ZIP COUPONS and EXCITE, simultaneously, products and retail stores are individually selected by the consumer.

Additionally, Scroggie discloses:

- using a first computer operated by a consumer to establish a connection with a second computer over a communication medium (col. 1 lines 47-64);
- using a second computer to acquire identifying indicia for identifying the geographical location of the first computer (col. 1 lines 52-61);
- selecting from a list of participating retail outlets stored in the second computer one or more participating retail outlets in the geographical vicinity of the first computer (col. 1 line 47 - col. 2 line 17);
- disclosing the steps include logging in a remotely located customer using identity data and geographic region data transmitted by the customer over a communication network; transmitting back to the registered customer a plurality of incentive offers, the incentive offers being exercisable in the customer's geographic region; and then receiving incentive offer selection data from the customer over the communication network, the offer selection data including the designation of a retailer at which selected offer or offers may be exercised (col. 1 lines 56-64);

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- the functionality of transmitting back to the registered customer a plurality of incentive offers, the incentive offers being exercisable in the customer's geographic region (col. 1 lines 56-64);
- receiving incentive offer selection data from the customer over the communication network, the offer selection data including the designation of a retailer at which selected offer or offers may be exercised (col. 1 lines 56-64); and
- An important element of the invention is that it permits the customer to plan his or her shopping and shopping-related activities more efficiently ... To this end, the method also includes the step of communicating with the customer concerning the use of shopping aids other than incentives or coupons ... In one aspect of the invention, this communicating step includes transmitting a list of products available for purchase, receiving customer selections from the list of products, and then transmitting a shopping list to the customer (col. 2 lines 8-17).

Therefore, it would have been obvious to one skilled in the art at the time the invention was made to modify the inventions of ZIP COUPONS and EXCITE to include displaying the list of the inventory of goods offered for sale by the selected retail outlet on the first computer such that the displayed inventory of goods are individually selectable by the consumer using the first computer so that the consumer may select one or more items of goods the consumer intends to purchase at the selected retail outlet, as disclosed by Scroggie et al., because

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this provides desirable and well known capabilities to the consumer/shopper and may influence the shopping habits of the consumer/shopper at the selected retail outlet or store.

Claim 2: ZIP COUPONS discloses means for acquiring identifying indicia for identifying the geographical location of a consumer unit connected thereto; selecting one or more participating retail outlets in the vicinity of the consumer unit; and downloading for display on the display monitor of the consumer unit the first file containing a list of the selected retail outlets (pg. 1 para. 2), e.g., *customers will select the US Postal zip code area where they want to shop and then select a coupon interest category for car wash, pizza,*

Claim 4: ZIP COUPONS discloses means for transmitting a file to the consumer unit containing a form requesting the consumer to identify the geographical location of the consumer unit (pg. 1 para. 2), *where customers select the U.S. Postal zip code area where they want to shop.*

Claim 5: ZIP COUPONS discloses a hardcopy apparatus for producing a hardcopy of electronic coupons transmitted to the consumer unit (pg. 1 para. 2), *as inferred by the capability where the customer can print out the desired coupons.*

Claim 6: ZIP COUPONS discloses a printer connected to a consumer unit (pg. 1 para. 2), *as inferred by the capability where the customer can print out the desired coupons.*

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Claim 7: ZIP COUPONS and EXCITE do not explicitly disclose a point-of-sale unit located in a participating retail outlet, or a hardcopy apparatus.

However, Official Notice is taken that it was old and well known at the time the invention was made that userstations or terminals for consumers' use were made available at participating retail outlets, e.g., in kiosks. Here, consumers may search for information on goods and products sold by the participating retail outlet and print coupons, as desired. Additionally, Official Notice is taken that it was old and well known in the art at the time the invention was made that a computer typically is comprised of a display monitor, a memory for storing data to be displayed on the display monitor, a data processing unit; a hardcopy apparatus, a user input device, or any additional devices that are considered necessary for operation in a particular manner. Therefore, it would have been obvious to one skilled in the art at the time the invention was made to combine ZIP COUPONS, EXCITE and old and well known art to disclose a point of sale unit comprising a hardcopy apparatus, a display monitor, a memory for storing data to be displayed on the display monitor, a data processing unit, a hardcopy apparatus, and a user input device, because this configuration provides functionality that is necessary for the invention to operate.

Claim 8: ZIP COUPONS discloses:

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- the coupon server is located remotely from the point-of-sale unit (pg. 1 para. 2), and further comprises:
- means for transmitting to the point-of-sale unit a fourth file containing the identity of coupons for goods offered for sale by the retail outlet at which the point-of-sale unit is located (pg. 1 para. 2); which infers that goods for sale are identified by the list of coupons available.

ZIP COUPONS does not explicitly disclose the third means of the coupon server is responsive to the selection of one or more items of goods by the consumer to transmit the third file for display on the display monitor of the point-of-sale unit containing second data corresponding to the selected goods, the third file containing electronic coupons corresponding to one or more of the selected goods. However, ZIP COUPONS does disclose the user selecting a postal ZIP code area where they want to shop (i.e., which can be remote from the coupon server), selecting coupons to be provided to the user from a displayed list of coupons for a coupon interest category selected by and displayed to the user, for goods that the user is interested in purchasing (pg. 1 para. 2). Further, EXCITE discloses *enables consumer access to valuable promotional offers matched to their shopping interests* (pg. 2 3rd para.), i.e., products that the consumer is interested in. Therefore it would have been obvious to one skilled in the art at the time the invention was made to use the methods of ZIP COUPONS in combination with EXCITE and Scroggie et al. to disclose the third means of the coupon server is responsive to the selection of

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one or more items of goods by the consumer to transmit the third file for display on the display monitor of the point-of-sale unit containing second data corresponding to the selected goods, the third file containing electronic coupons corresponding to one or more of the selected goods, because this would provide the user with the coupons provided by selected merchants for the purchase of their products, thus encouraging shopping at their establishments.

Claim 12: ZIP COUPONS discloses one or more consumer units comprise client computers on a network (pg. 1 para. 2).

Claim 13: ZIP COUPONS discloses the coupon server comprises an Internet host computer (pg. 1 para. 2).

7. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over "Internet Infinity Signs Exclusive Distribution Agreement With ZIP COUPONS;" PR Newswire; p106NYM035; 06 January 1997 (hereafter referred to as "ZIP COUPONS"), and further in view of "Excite Reports First Quarter 1999 Results," PR Newswire, 15 April 1999 (hereafter referred to as Excite), Scroggie et al. (U.S. Patent No. 6,014,634), and Katz et al. (U.S. Patent No. 6,055,513).

Claim 3: ZIP COUPONS discloses the communication medium comprises a public telephone network (col. 8 lines 2-7). ZIP COUPONS, Excite and Scroggie

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et al. do not disclose means for acquiring caller ID data to identify the geographical location of the consumer unit. However, Katz et al. disclose:

- the communication medium comprises a public telephone network (col. 15 lines 38-65), and
- means for acquiring caller ID data to identify the geographical location of the consumer unit (col. 16 lines 9-17).

Therefore, it would have been obvious to one skilled in the art at the time the invention was made to combine ZIP COUPONS, Excite, Scroggie et al., and Katz et al. to disclose the communication medium comprises a public telephone network and means for acquiring caller ID data to identify the geographical location of the consumer unit, because this capability provides obvious and useful enhancements to the invention for the expeditious identification of callers.

8. Claim 11, 29-30, and 32-40 are rejected under 35 U.S.C. 103(a) as being unpatentable over "Internet Infinity Signs Exclusive Distribution Agreement With ZIP COUPONS;" PR Newswire; p106NYM035; 06 January 1997 (hereafter referred to as "ZIP COUPONS"), and further in view of "Excite Reports First Quarter 1999 Results," PR Newswire, 15 April 1999 (hereafter referred to as EXCITE), Scroggie et al. (U.S. Patent No. 6,014,634), and Burke (U.S. Patent No. 5,848,399).

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Claim 11: ZIP COUPONS, Scroggie et al., and EXCITE do not disclose the second file contains graphical data for displaying a representation of the physical layout of the goods in the selected retail outlet. However, Burke discloses an output of the retail space management system 52 is a three-dimensional description 56 of the store space, including product descriptions (UPC information), shelf and product sizes and locations in three spatial dimensions, and product category locations, preferably in Cartesian coordinates. Typically, the description 56 includes a floor plan which indicates the location and sizes of each product category within the store. A file is also generated for each product category, indicating the product and shelf sizes and locations for the product category. This description 56 can be stored in a store database 61, accessible by an indication of the store 59 which it describes (col. 4 lines 58-67; col. 5 lines 1-25). Therefore, it would have been obvious to one skilled in the art at the time the invention was made to modify the invention of the combination of ZIP COUPONS, Scroggie et al., and EXCITE to disclose data representative of the physical layout of the participating retail outlets indicating the aisle location of the goods offered for sale, as disclosed by Burke, because this enhances the invention's desirability to consumers through the ease of locating desirable products in a store and may enhance customer attraction to the merchant.

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Claim 29: Claim 29 is written as a system and contains essentially the same limitations as the combination of claims 1 and 11; therefore, the same rejection is applied.

Claim 30: Claim 30 is written as a system and contains essentially the same limitations as claim 2; therefore, the same rejection is applied.

Claim 32: Claim 32 is written as a system and contains essentially the same limitations as claim 4; therefore, the same rejection is applied.

Claim 33: Claim 33 is written as a system and contains essentially the same limitations as claim 5; therefore, the same rejection is applied.

Claim 34: Claim 34 is written as a system and contains essentially the same limitations as claim 6; therefore, the same rejection is applied.

Claim 35: Claim 35 is written as a system and contains essentially the same limitations as claim 7; therefore, the same rejection is applied.

Claim 36: Claim 36 is written as a system and contains essentially the same limitations as claim 8; therefore, the same rejection is applied.

Claim 37: Claim 37 is written as a system and contains essentially the same limitations as claim 11; therefore, the same rejection is applied.

Claim 38: Claim 38 is written as a system and contains essentially the same limitations as claim 13; therefore, the same rejection is applied.

Claim 39: Claim 39 is written as a system and contains essentially the same limitations as claim 13; therefore, the same rejection is applied.

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Claim 40: Claim 40 is written as a system and contains essentially the same limitations as the combination of claims 1 and 11; therefore, the same rejection is applied.

9. Claim 31 is rejected under 35 U.S.C. 103(a) as being unpatentable over "Internet Infinity Signs Exclusive Distribution Agreement With ZIP COUPONS;" PR Newswire; p106NYM035; 06 January 1997 (hereafter referred to as "ZIP COUPONS"), and further in view of "Excite Reports First Quarter 1999 Results," PR Newswire, 15 April 1999 (hereafter referred to as Excite), Scroggie et al. (U.S. Patent No. 6,014,634), Burke (U.S. Patent No. 5,848,399), and Katz et al. (U.S. Patent No. 6,055,513).

Claim 31: Claim 31 is written as a system and contains essentially the same limitations as claim 3; therefore, the same rejection is applied.

10. Claims 25-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over "Internet Infinity Signs Exclusive Distribution Agreement With ZIP COUPONS;" PR Newswire; p106NYM035; 06 January 1997 (hereafter referred to as "ZIP COUPONS"), and further in view of Scroggie et al (U.S. Patent No. 6,014,634) and Burke (U.S. Patent No. 5,848,399).

Claim 25: ZIP Coupons (see pg. 1 para. 2) discloses:

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- using a first computer operated by a consumer to establish a connection with a second computer over a communication medium, *i.e., through their Internet connectivity*; and
- using a second computer to acquire identifying indicia for identifying the geographical location of the first computer; selecting from a list of participating retail outlets stored in the second computer one or more participating retail outlets in the geographical vicinity of the first computer; transmitting from the second computer to the first computer a first file containing the selected one or more participating retail outlets, each of which may be individually selected by the consumer using an input device; displaying on the first computer the list of the one or more selected participating retail outlets contained in the first file; transmitting from the second computer to the first computer a second file containing data corresponding to the selected retail outlet including a list of the inventory of goods offered for sale by the selected retail outlet; displaying the list of the inventory of goods offered for sale by the selected retail outlet on the first computer such that the displayed inventory of goods are individually selectable by the consumer using the first computer so that the consumer may select one or more items of goods the consumer intends to purchase at the selected retail outlet, as disclosed by Zip Coupons:

-- *by customers will go the planned Internet site ... via their computer or television, to obtain coupons for use in their local trading area ...*

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-- *Customers will select the US Postal zip code area where they want to shop and then select a coupon interest category for car wash, pizza, dentist, pet care, health care, etc.*

-- *After viewing available coupons (which infers the customer viewing a list of products), the customer either can print out the desired coupons or use the on-line discount code number to participate in the merchant's special offer, which infers the customer choosing coupons which identify associated merchants (i.e., choosing desired merchants) from those presented for the geographical area (US Postal zipcode area) identified by customer (i.e., for trading in his local trading area of choice).*

Additionally, Scroggie discloses:

- using a first computer operated by a consumer to establish a connection with a second computer over a communication medium (col. 1 lines 47-64);
- using a second computer to acquire identifying indicia for identifying the geographical location of the first computer (col. 1 lines 52-61);
- selecting from a list of participating retail outlets stored in the second computer one or more participating retail outlets in the geographical vicinity of the first computer (col. 1 line 47 - col. 2 line 17);
- transmitting from the second computer to the first computer a first file containing the selected one or more participating retail outlets, each of which may be individually selected by the consumer using an input device (col. 1 lines

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56-64), *disclosing the steps include logging in a remotely located customer using identity data and geographic region data transmitted by the customer over a communication network; transmitting back to the registered customer a plurality of incentive offers, the incentive offers being exercisable in the customer's geographic region; and then receiving incentive offer selection data from the customer over the communication network, the offer selection data including the designation of a retailer at which selected offer or offers may be exercised;*

- displaying on the first computer the list of the one or more selected participating retail outlets contained in the first file (col. 1 lines 56-64), *through the functionality of transmitting back to the registered customer a plurality of incentive offers, the incentive offers being exercisable in the customer's geographic region;*

- transmitting from the second computer to the first computer a second file containing data corresponding to the selected retail outlet including a list of the inventory of goods offered for sale by the selected retail outlet (col. 1 lines 56-64), *through receiving incentive offer selection data from the customer over the communication network, the offer selection data including the designation of a retailer at which selected offer or offers may be exercised; and*

- displaying the list of the inventory of goods offered for sale by the selected retail outlet on the first computer such that the displayed inventory of goods are individually selectable by the consumer using the first computer so that the

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consumer may select one or more items of goods the consumer intends to purchase at the selected retail outlet (col. 2 lines 8-17).

Neither Zip Coupons nor Scroggie et al. disclose transmitting from the second computer to the first computer a file containing data identifying the physical aisle location in the selected retail outlet of the goods selected by the consumer. However, Burke discloses an output of the retail space management system 52 is a three-dimensional description 56 of the store space, including product descriptions (UPC information), shelf and product sizes and locations in three spatial dimensions, and product category locations, preferably in Cartesian coordinates (col. 4 lines 58-67; col. 5 lines 1-25). Also, Official Notice is taken that it was old and well known in the art at the time the invention was made that the use of a database allows the cross-correlation of data relative to common features, characteristics or descriptors. Such cross-correlation of data allows the functionality of determining the physical location of specific products within a retail store and portraying the location information for specific products to the user, when the specific products are selected for purchase. This would require simple database search and display functions that are old and well known in the computer and database arts. Additionally, the functionality of the inventions of ZIP Coupons and Scroggie et al. discloses a database for data storage and retrieval. Also, Official Notice is taken that data that may be stored in a database may take any of many forms or formats, as may be required by the inventor for

the desired functionality of the database, such as may be required to display a map, a table or a list. Therefore, it would have been obvious to one skilled in the art at the time the invention was made to modify the inventions of ZIP COUPONS and Scroggie et al. to disclose data representative of the physical layout of the participating retail outlets indicating the aisle location of the goods offered for sale, as disclosed by Burke, because this enhances the invention to consumers through the ease of generating a shopping list of desirable products from available products in a retail outlet and locating these desirable products in the retail outlet when shopping with the list.

Claim 26: ZIP COUPONS discloses (see pg. 1 para. 2) the communication medium comprises the Internet, the first computer comprises a client computer; and the second computer comprises an Internet host computer.

Claim 27: ZIP COUPONS and Scroggie et al. do not explicitly disclose the step of transmitting from the second computer to the first computer a second file further comprises the step of transmitting data representative of the physical layout of the selected retail outlet indicating the physical location of the goods offered for sale by the selected retail outlet. However, Burke discloses the step of transmitting from the second computer to the first computer a second file further comprises the step of transmitting data representative of the physical layout of the selected retail outlet indicating the physical location of the goods

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offered for sale by the selected retail outlet (col. 4 lines 58-67; col. 5 lines 1-25).

Therefore, it would have been obvious to one skilled in the art at the time the invention was made to modify the inventions of ZIP COUPONS and Scroggie et al. to disclose the step of transmitting from the second computer to the first computer a second file further comprises the step of transmitting data representative of the physical layout of the selected retail outlet indicating the physical location of the goods offered for sale by the selected retail outlet, as disclosed by Burke, because this aids customers who generate shopping lists in finding the items they have selected to purchase in the retail outlet.

Claim 28: ZIP Coupons (see pg. 1 para. 2) discloses the step of transmitting from the second computer to the first computer a file containing electronic coupons corresponding to one or more of the selected goods in response to the selection of one or more items of goods by the consumer.

Response to Arguments

11. Applicant's arguments filed 22 April 2002 have been fully considered but they are not persuasive.

Applicant states, on pg. 12-16, The present invention relates to a data processing system and method for the interactive generation of a personalized shopping list over a network, the shopping list being customized to reflect a consumer's choice of a specific retail outlet by specifying aisle locations of goods

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selected for purchase by the consumer. The present invention also generates coupons based on the consumer's selection of goods. In accordance with independent claims 1 and 25, a consumer is shown one of a generic list of goods generally sold in a selected type of retail outlet or a specific list of goods sold in an actual retail outlet selected by the consumer. once the consumer has indicated their items he or she plans to purchase from the displayed generic or specific list, the system returns to the consumer a shopping list that is customized to indicate the aisle locations of each intended purchase, within the selected retail outlet. The shopping list obtained becomes a roadmap of the selected retail outlet so the shopper can shop more efficiently . . .

The independent claims recite subject matter that is not disclosed or rendered obvious by the cited prior art.

Zip Coupons, either alone or in combination with the one or more of Storey, Scroggie et al. Excite, and Katz et al., does not disclose a system for performing all of the following steps: (1) displaying a list of participating, individually-selectable retail outlets; (2) displaying a list of either the inventory of goods offered for sale by a selected retail outlet or goods generally sold by a particular type of retail outlet selected by the consumer; (3) allowing the consumer to select one or more of the displayed goods; (4) providing a shopping list identifying the physical location (aisle number) of the selected goods in the selected retail outlet; and (5) generating coupons for the selected goods after the foregoing selections are made.

Examiner disagrees. Examiner maintains that the prior art identified in the rejection above discloses the functionality of applicant's invention. Specifically, the combinations of the following statements provide a summary of the rejection stated above, for the five (5) elements identified and argued by applicant:

(1) displaying a list of participating, individually-selectable retail outlets:

Excite discloses, on pg. 2, Through Excite, consumers will now be able to access digital redeemable coupons from participating online merchants, all personalized based on an individual's shopping interests, which infers consumer access to coupons.

ZIP COUPONS disclose, on pg. 1, that advertisers will pay Internet Infinity, Inc for placement of their zip coupons on the Internet and delivery of their mail coupon, and customers will select a coupon interest category for car wash, pizza, etc., which implies that a list of categories of the participating retail outlets are displayed on the display monitor of the consumer unit.

Zip Coupons also disclose, on pg. 1, Customers will select the US Postal zip code area where they want to shop and then select a coupon interest category for car wash, pizza, dentist, pet care, health club, etc. After viewing available coupons, the customer either can print out the desired coupons or use the on-line discount code number to participate in the merchant's special offer, which implies that a list of the participating retail outlets are displayed on the display monitor of the consumer unit.

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(2) displaying a list of either the inventory of goods offered for sale by a selected retail outlet or goods generally sold by a particular type of retail outlet selected by the consumer:

Examiner maintains that this is disclosed by prior art, as presented in the rejection above, and identified below:

Excite discloses, on pg. 2, Through Excite, consumers will now be able to access digital redeemable coupons from participating online merchants, all personalized based on an individual's shopping interests.

ZIP COUPONS disclose, on pg. 1, that advertisers will pay Internet Infinity, Inc. a fee for placement of their zip coupons on the Internet and delivery of their mail coupon, and customers will select a coupon interest category for car wash, pizza, etc., which implies that a list of categories of the participating retail outlets are displayed on the display monitor of the consumer unit.

Zip Coupons also disclose, on pg. 1, Customers will select the US Postal zip code area where they want to shop and then select a coupon interest category for car wash, pizza, dentist, pet care, health club, etc. After viewing available coupons, the customer either can print out the desired coupons or use the on-line discount code number to participate in the merchant's special offer, which implies that a list of available coupons for available goods is displayed on the display monitor of the consumer unit for selection by the consumer.

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(3) allowing the consumer to select one or more of the displayed goods;

Excite discloses, on pg. 2, Through Excite, consumers will now be able to access digital redeemable coupons from participating online merchants, all personalized based on an individual's shopping interests, which implies that a customer may select one or more coupons, and that the coupons presented for selection are based on a customer's shopping interests.

Zip Coupons also disclose, on pg. 1, Customers will select the US Postal zip code area where they want to shop and then select a coupon interest category for car wash, pizza, dentist, pet care, health club, etc. After viewing available coupons, the customer either can print out the desired coupons or use the on-line discount code number to participate in the merchant's special offer, which discloses selection by the consumer of desired coupons (and products/items).

(4) providing a shopping list identifying the physical location (aisle number) of the selected goods in the selected retail outlet;

EXCITE discloses that consumers are able to access digital redeemable coupons from participating online merchants, all personalized based on an individual's shopping interests (pg. 2 3rd para.), as may be portrayed by a shopping list.

Burke discloses an output of the retail space management system 52 is a three-dimensional description 56 of the store space, including product

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descriptions (UPC information), shelf and product sizes and locations in three spatial dimensions, and product category locations, preferably in Cartesian coordinates. Typically, the description 56 includes a floor plan which indicates the location and sizes of each product category within the store. A file is also generated for each product category, indicating the product and shelf sizes and locations for the product category. This description 56 can be stored in a store database 61, accessible by an indication of the store 59 which it describes (col. 4 lines 58-67; col. 5 lines 1-25).

Scroggie et al. discloses An important element of the invention is that it permits the customer to plan his or her shopping and shopping-related activities more efficiently ... To this end, the method also includes the step of communicating with the customer concerning the use of shopping aids other than incentives or coupons ... In one aspect of the invention, this communicating step includes transmitting a list of products available for purchase, receiving customer selections from the list of products, and then transmitting a shopping list to the customer (col. 2 lines 8-17).

(5) generating coupons for the selected goods after the foregoing selections are made.

EXCITE discloses that consumers are able to access digital redeemable coupons from participating online merchants, all personalized based on an

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individual's shopping interests (pg. 2 3rd para.), as may be portrayed by a shopping list.

Also, Zip Coupons discloses, on pg. 1, Customers will select the US Postal zip code area where they want to shop and then select a coupon interest category for car wash, pizza, dentist, pet care, health club, etc. After viewing available coupons, the customer either can print out the desired coupons or use the on-line discount code number to participate in the merchant's special offer.

Additionally, Scroggie discloses:

- disclosing the steps include logging in a remotely located customer using identity data and geographic region data transmitted by the customer over a communication network; transmitting back to the registered customer a plurality of incentive offers, the incentive offers being exercisable in the customer's geographic region; and then receiving incentive offer selection data from the customer over the communication network, the offer selection data including the designation of a retailer at which selected offer or offers may be exercised (col. 1 lines 56-64);
- the functionality of transmitting back to the registered customer a plurality of incentive offers, the incentive offers being exercisable in the customer's geographic region (col. 1 lines 56-64);
- receiving incentive offer selection data from the customer over the communication network, the offer selection data including the designation of a

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retailer at which selected offer or offers may be exercised (col. 1 lines 56-64);

and

- An important element of the invention is that it permits the customer to plan his or her shopping and shopping-related activities more efficiently ... To this end, the method also includes the step of communicating with the customer concerning the use of shopping aids other than incentives or coupons ... In one aspect of the invention, this communicating step includes transmitting a list of products available for purchase, receiving customer selections from the list of products, and then transmitting a shopping list to the customer (col. 2 lines 8-17).

Examiner asserts that the functionality disclosed by prior art discloses applicant's invention, as stated in the rejection of claims in sections 6-10 above. Therefore, the rejection is maintained.

Conclusion

12. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory


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action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Forest O. Thompson Jr. whose telephone number is (703) 306-5449. The examiner can normally be reached on 6:30-3:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wynn Coggins can be reached on (703) 308-1344. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-7687 for regular communications and (703) 305-7687 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.


F. Thompson
June 28, 2002


WYNN W. COGGINS
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3800